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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,603	12/17/2001	James P. Snyder	EMU 2090 US	2890

20786 7590 03/21/2003

KING & SPALDING
191 PEACHTREE STREET, N.E.
ATLANTA, GA 30303-1763

EXAMINER

FONDA, KATHLEEN KAHLER 7

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 03/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/023,603

Applicant(s)

SNYDER ET AL.

Examiner

Kathleen Kahler Fonda, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 7, 13, 19, and 25, as well as claims 31-33 insofar as they depend from claims 19 and 25, drawn to a nitrogen-containing compound, pharmaceutical compositions comprising it, and therapeutic methods employing it, classified in class 514, subclass 659+.
- II. Claims 2, 8, 14, 20, and 26, as well as claims 31-33 insofar as they depend from claims 20 and 26, drawn to a nitrogen-containing compound, pharmaceutical compositions comprising it, and therapeutic methods employing it, classified in class 514, subclass 639+.
- III. Claims 3, 9, 15, 21, and 27, as well as claims 31-33 insofar as they depend from claims 21 and 27, drawn to a nitrogen-containing compound, pharmaceutical compositions comprising it, and therapeutic methods employing it, classified in class 514, subclass 602+.
- IV. Claims 4, 10, 16, 22, and 28, as well as claims 31-33 insofar as they depend from claims 22 and 28, drawn to a nitrogen-containing compound, pharmaceutical compositions comprising it, and therapeutic methods employing it, classified in class 514, subclass 228.8+.

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- V. Claims 5, 11, 17, 23, and 29, as well as claims 31-33 insofar as they depend from claims 23 and 29, drawn to a nitrogen-containing compound, pharmaceutical compositions comprising it, and therapeutic methods employing it, classified in class 514, subclass 278+.
- VI. Claims 6, 12, 18, 24, and 30, as well as claims 31-33 insofar as they depend from claims 24 and 30, drawn to a nitrogen-containing compound, pharmaceutical compositions comprising it, and therapeutic methods employing it, classified in class 514, subclass 218+.

The inventions are distinct, each from the other because inventions I-VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together, and they employ different nitrogen-containing compounds which are not obvious over each other.

Each of claims 1-6 is generic to a plurality of disclosed patentably distinct nitrogen-containing compounds. Regardless of which of Groups I-VI above is elected for prosecution,

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APPLICANT IS FURTHER REQUIRED UNDER 35 U.S.C. 121 to elect a single disclosed species from within the elected Group, even though this requirement is traversed..

Should Applicant traverse on the ground that the species are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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The Examiner has made certain observations about the claims which Applicant may wish to consider prior to full examination on the merits. First, the language "defined above" in an independent claim may be seen as rendering the claim indefinite, because a claim must stand alone to define the intended subject matter. Second, claim 33 is an improper multiple dependent claim because it depends from multiple dependent claims 31 and 32.

Papers relating to this application may be submitted to Technology Center 1600 by facsimile transmission. The number of the fax machine for official papers in Technology Center 1600 is (703) 308-4556. Any document submitted by facsimile transmission will be considered an official communication unless the cover sheet clearly indicates that it is an informal communication.

INTERNET INFORMATION: Secure and confidential access to patent application status information is now available; see <http://www.uspto.gov/ebc/index.html> for more information. Also, <http://www.uspto.gov/web/offices/ac/comp/fin/clonedefault.htm> may be used to pay patent maintenance fees, pay non-filing application fees, and maintain USPTO deposit accounts.

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Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kathleen Kahler Fonda, at telephone number (703) 308-1620. Examiner Fonda can generally be reached Monday through Friday from 7:30 a.m. until 4:00 p.m. If the Examiner cannot be reached, questions may be addressed to Supervisory Patent Examiner James O. Wilson at (703) 308-4624. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-1235.



Kathleen Kahler Fonda, Ph.D., J.D.
Primary Examiner
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